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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,057	08/07/2000	Patrick Humbert	Q60128	9140

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,057

Applicant(s)

HUMBERT ET AL

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

A new drawing was received on 6/07/05. This drawing is not acceptable because it contains new matter. There is no support for having the box being labeled "12". Most notably, page 6, lines 29-36 requires structure 12 to be part of the support means 7.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: There is no feature 12 in the drawings; page 6, line 36 and page 7, line 5 describe two different features 12.. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "12" has been used to designate both a servo control means (page 6, line 36) and a computer (page 7, line 5). Corrected drawing sheets in

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compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "servo-controller" (claim 12) could not be found in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the servo-controller as presently claimed. First there is no explicit support for a “servo-controller” – it is not even mentioned. Whereas there is reasonable implicit support for a servo-controller, Examiner could not find support for the specific servo-controller as presently claimed.

There doesn't appear to be any explicit support for the servo-controller being coupled to the sensor.

Most importantly, starting at line 29 of page 6 of the present specification, the invention is described such that the servo-control means (12: not shown in drawings) is part of the controlled support means 7. However, the box (in the lower left hand corner of figure 1) is not part of 7 (see all figures). But it is this box (NOT the servo controller) which is coupled to the sensor 9. Of course, all features of the machine are physically connected/coupled together – but that doesn't seem to be a reasonable interpretation –

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because it is already clear that everything is connected. So, the reasonable interpretation would be that they are electronically coupled – so that at least one gets an electronic signal (substantially directly) from the other.

This is deemed to be a prima facie showing on failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenship 4310339 in view of Sharp 4867776, Mimura 4729777, Bickel DE 4009484 and Hara 4552576.

Blankenship, Sharp, and Mimura are applied in the same manner as in the previous Office action (included below). However Blankenship has the preform in a vertical orientation – not the claimed horizontal direction. However, it is conventional to make preforms horizontally as disclosed in Hara. Bickel discloses (see English language abstract) that producing fibers horizontally has the advantage of not needing a high draw turret – (i.e. one need not have a two story building or higher). It would have been obvious to orient the Blankenship apparatus horizontally, so that one does not need a high drawing turret.

As to the preamble, it is deemed that the preamble does not breathe life and meaning to the claims – because there is no mention of the apparatus or the installation in the body of the claim. Alternatively, it is deemed that the Blankenship invention is an installation in as much as the instant invention is an installation.

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Figures 4-6 of Blankenship disclose the invention. 26 or 40 is the preform having the supporting core (see Example II, col. 11) . Col. 6, lines 40-42 discloses a rotation mechanism. Feature 36 is the support member; it is adjustable (col. 8, lines 7-10). Feature 37 is the rotatable wheel.

Blankenship's wheel is not disclosed as having a tread strip. It is known in the fiber making art that having a rubber coating (i.e. a type of tread strip) on a wheel prevents the scratching of glass. See Col. 4, lines 1-11 of Sharp. Furthermore, it is known that scratched preforms result in weakened fibers (See Mimura, col. 4, lines 24-30). It would have been obvious to use rubber coated wheels as the Blankenship wheels so as to prevent scratches that will weaken the fibers.

Response to Arguments

Applicant's arguments with respect to claim 11 have been considered but are moot in view of the new ground(s) of rejection.

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It is argued that page 6 line 36 – page 7, line 2 provides antecedent basis for the term “servo-controller”. Whereas Examiner sees similar terminology, Examiner could not find the term “servo-controller” anywhere.

In regards to the 112 – first paragraph rejection, it is argued that pages 6 and 7 provide sufficient information to enable one to make and use the invention. This is largely immaterial because the rejection is not a non-enablement rejection. See the rejection.

It appears that Applicant is saying the computer is the servo control means. No discussion of this could be found in the disclosure. It is clear that there is a typographical error and that the computer and the servo-control means are two separate things. As indicated above, page 6, lines 29-37 indicate that the servo-control means is part of the support means 7.

Regarding the prior art, the only argument that still pertains is the one regarding the wheel that is mounted to rotate freely. It is argued that Blankenship does not teach a wheel that is not driven, but rotate freely. This is immaterial. The claims do not require that the wheel be “not driven”. It is clear that Applicant’s wheel is driven when it is contact with the preform.

Still further, if one adjusts the Blankenship wheels so the teeth of the gears do not mesh, then the wheels will rotate freely like Applicants. It does not seem reasonable that applicant’s claims permit adjusting the wheel location so that they can

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or cannot rotate freely, but then the prior art cannot be interpreted with similar adjustment.

Rotation is a method of use, not structure. It is noted that when Applicant's wheel is serving its purpose, it does not rotate freely – it is driven by the preform.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

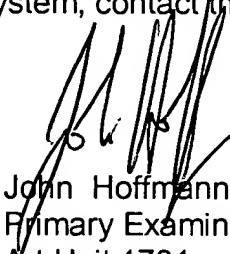
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

7-1-05

jmh